

REMARKS

The above amendments and following remarks are submitted in response to the Final Official Action of the Examiner mailed October 9, 2002. Having addressed all objections and grounds of rejection, claims 1-20, being all the pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

The Examiner has rejected claims 1-4, 6-9, and 16-18 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,256,624, issued to Pollard et al (hereinafter referred to as "Pollard"). This ground of rejection is respectfully traversed.

"It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention, and that such a determination is one of fact". *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 90 (Fed. Cir. 1986). The rejection is respectfully traversed because Pollard does not meet every element of the claimed invention.

Claim 1, as amended, is limited by:

- 1) user terminal which generates a service request and displays a report;
- 2) software controlled server responsively coupled to said

user terminal via said publically accessible digital communications network;

3) administration module which determines a first time to generate a report;

4) software module which executes a sequence of command script statements to generate a report; and

5) storage facility which spools said report in HTML format for future delivery at a second predetermined time.

Pollard does not contain any of these elements. The reference has no such service requesting and report displaying user terminals. The Examiner has cited column 1, lines 44-46, and column 4, lines 63-66. Neither of these citations even mentions a user terminal, much less a user terminal having the limiting functionality.

Pollard has no software controlled server. In his arguments the Examiner states:

It is the examiner's view that the entire system (computer system 110, report production facility 160, and delivery system 190), together constitute 'the server' in the embodiment of the system where the Internet is used for distribution of the reports.

Though the Examiner has attempted to stretch the definition of "server" to include the miscellaneous structures of Pollard, he certainly cannot assert that these structures are software controlled. The Examiner's definition of 'server' includes "a report transfer system 180 (e.g., trucking service)...". The

Examiner is reminded of MPEP 2173.01 which provides in part:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers.

Within the bounds of MPEP 2173.01, the Examiner is obligated, as a matter of law, to accept Applicant's definition of 'server'.

Pollard makes no mention of an administration module. The claimed storage facility is limited to storage of the report in HTML format. Pollard makes no mention of such structure. Thus, claim 1, as amended, and the claims depending therefrom are deemed to be patentable over the prior art of record. Claims 6 and 16, as amended, and the claims depending therefrom are deemed patentable for similar reasons.

Claims 11-14 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,956,693, issued to Geerlings (hereinafter referred to as "Geerlings"). This ground of rejection is respectfully traversed for the following reasons.

Claim 11 is a method claim having five basic steps:

- 1) automatically generating;
- 2) converting into HTML;
- 3) spooling HTML;
- 5) making a service request; and
- 6) transmitting HTML.

Geerlings shows none of these steps. With regard to the first step (i.e., automatically generating a report), the Examiner cites column 3, lines 10-12 and column 5, lines 33-40. Neither of these

citations teaches "automatically generating a report by a database management system in response to a sensed signal at a first predetermined time" which is limiting of claim 11. Furthermore, this limitation has been further narrowed to specific details for the generation of the report.

With regard to the second step, the Examiner offers three citations which tangentially mention Internet communication. However, none of these citations says anything about conversion of a report into HTML, so it is problematic to determine the Examiner's intention with regard to these citations. Because the Internet facilitates communication using a wide variety of formats, conversion to HTML is not inherent in Internet communication. Guidance with regard to the matter of inherency is provided by MPEP 2112, which states in part:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO
SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). >"To establish inherency, the extrinsic evidence `must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "In re Robertson, 169

F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

As to the third step, the Examiner adds a fourth citation (i.e., column 5, lines 33-57) which also says nothing of "spooling said HTML display page within a repository".

Step four recites "making a service request from said user terminal to said data base management system". In his rejection, the Examiner mysteriously cites column 2, lines 26-27, which states (full sentence given):

In particular, initiation of a desired communication may be based on a specific purchase made by a recipient or the passage of a certain length of time from a specific shopping activity by the recipient, or the last inquiry made by the recipient and seasonal activity by recipients, for example.

It is absolutely baffling that the Examiner could consider this to be "making a service request from said user terminal to said data base management system".

The citations regarding the fifth step are equally confusing. The claim limitation refers to displaying the report (i.e., "output"). The citations from Geerlings refer to data collection (i.e., "input"). Therefore, the rejection of claim 11 and claims depending therefrom is respectfully traversed for failure of Geerlings to teach the elements of the claimed invention.

The rejections of claims 12-14 are similarly defective and respectfully traversed for the same reasons.

The Examiner has rejected claim 10 under 35 U.S.C. 103 as being unpatentable over Pollard in view of Geerlings. This ground of rejection is respectfully traversed for failing to show all of the claimed elements as explained above. Furthermore, the Examiner has failed to show motivation or reasonable likelihood of success of the alleged combination of Pollard and Geerlings as required by MPEP 2143. Specifically, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare reports to be delivered to a user terminal comprising an industry compatible personal computer having a web browser, since by definition such computers are ubiquitous within the computer art, and as such it would have been obvious to prepare reports that were capable of being received and displayed on such machines.

In other words, because computers exist, anything done using those existing computers is obvious. This finding is both incorrect as a matter of law and incorrect as a matter of logic. The rejection of claim 10 is therefore respectfully traversed.

The Examiner utilizes the same defective reasoning with regard to his rejection of claim 20. Therefore, the rejection of claim 20 is respectfully traversed.

A similar defect in the application of logic and law occurs with the Examiner's rejection of claims 5 and 19. He states:

It would have been obvious to one of ordinary skill at the time of the invention to incorporate the CLASSIC MAPPER database management system, since it is admitted as prior art that CLASSIC MAPPER is one of the most successful database management systems (see page 4, lines 9-12).

In other words, because Classic MAPPER exists, it is obvious to use it to prepare and distribute the printed, hard copy reports of Pollard. The rejection of claims 5 and 19 is respectfully traversed.

The rejection of claim 15 utilizes the same defective logic and is therefore similarly respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, as amended, being the only pending claims.

Respectfully submitted,

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